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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/679,856	19-Apr-01	SUSAMU TAKETOMI, ET AL	30812

Title: DISPERSED GLASS COMPOSITE INCLUDING RARE
EARTH IRON GARNET NANOPARTICLES

Art Unit	Paper Number
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LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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December 2, 2002

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In re: Taketomi et al
App'n No. 09/679,856
Submitted: 04/17 & 20/2001
Docket No. 30812

DECISION ON REQUEST
FOR RETROACTIVE LICENSE
UNDER 37 CFR 5.25

Title: GLASS COMPOSITE INCLUDING DISPERSED
RARE EARTH IRON GARNET NANOPARTICLES

This is a decision on applicants' petition for a retroactive foreign license under 37 CFR 5.25. Accompanying the petition are the declarations of R. W. Trewyn, the President of the Kansas State University Research Foundation, Kenneth J. Klabunde and Christopher M. Sorenson, two of the three inventors herein. For the reasons set forth below, this petition is DENIED.

The various declarations include information upon which this petition is based, but are unclear as to the specifics relating to events and filings in Japan and how they relate to the present application. It is clear that a publication was published on October 6, 1999 in Japan. Some "aspects of the disclosure" were part of the publication. It is not apparent, however, whether the material disclosed in the foreign newspaper was that of any or all applicants. Furthermore, if it is indeed material that is a part of this application, where was that portion of the invention made. If it is the work of another, then priority and due diligence are not at issue. If it is part of this case, a statement of the author(s) must be forthright as to the circumstances leading to the discovery (including statements of those who initially realized it to be an issue). The due diligence aspect must also be addressed.

A Japanese patent application was filed on April 5, 2000. Information about this filing is unclear. One of the inventors, Dr. Susamu Taketomi, and his employer, Matsumoto Yushi-Seiyaku Co., filed this case. There is no statement herein for the inventor, the employer, or the person responsible for the preparation of said application. Absent said firsthand declarations, it cannot be determined how this filing relates to the U. S. case. There is a statement from each of the other two inventors that it discloses and claims some of the subject matter herein, but they also state that they were unaware of its existence until shortly before the U. S. filing. The most telling statement is in paragraph six (6) of the statements of each of the two inventors herein. They both maintain "Dr. Taketomi has virtually all of the knowledge of the facts surrounding the filing of the earlier Japanese application". Without the Dr.'s statement as to the relevance, circumstances, disclosure and due diligence, this possible violation of foreign licensing requirements cannot be evaluated in a meaningful way. It may well be that the invention of said Japanese application may have been made in Japan, in which case there would be no violation. The statements of those responsible for said foreign filing are necessary. Also, a statement as to any other foreign activity



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involving this subject matter is required. This should include a definitive statement from those responsible for the Japanese case. The due diligence statements from those involved should include relevant dates and circumstances both from filing in Japan until discovery in September and from September until the filing of this petition.

The final issue that needs to be addressed is whether the problem was inadvertent. This also cannot be determined from the documentation to date. It is not clear whether MACC has a relationship with Matsumoto Yushi-Seiaku Co., Ltd. as to the development of various inventions, including those of Dr. Taketomi, or whether this was a one-time occurrence. If it were part of a relationship, what procedures were in place to ensure that U. S. laws were complied with before foreign dissemination of information? Also, what steps have been taken procedurally to avoid a recurrence of this problem? Without further information as to the circumstances, this cannot be said to be an inadvertent error.

The requirements of 37 CFR 5.25 having not been met, this petition is DENIED. A shortened statutory period for response is set to expire THREE (3) MONTHS from the date of this letter.

Peter A. Nelson
Primary Examiner
Licensing & Review
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